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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,981	12/03/2003	Michelle Suindall Berryman	97789.00003	5103
7590	12/21/2005			
Basam E. Nabulsi McCARTER & ENGLISH, LLP Four Stamford Plaza 107 Elm Street Stamford, CT 06902			EXAMINER PORTER, RACHEL L	
			ART UNIT 3626	PAPER NUMBER

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/726,981

Applicant(s)

BERRYMAN ET AL.

Examiner

Rachel L. Porter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/26/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed 12/3/03. Claims 1-14 are pending.

Priority

2. It is noted that this application appears to claim subject matter disclosed in prior Application No. 09/788,953, filed 2/20/01 and 10/134,003 filed 4/29/02. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or

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sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference

in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-12 rejected under 35 U.S.C. 103(a) as being unpatentable over d'Arbelles (USPN 6,286,682) in view of Keeton (USPN 4,947,867).

[claim 1] d'Arbelles discloses a method for conveying information concerning an individual, comprising:

- providing a plurality of tattoos, wherein each of said plurality of tattoos includes indicia that conveys predefined information related to a medical treatment parameter and wherein at least two of said plurality of tattoos includes indicia conveying different predefined treatment parameter information; (Fig. 1a, 2)
- deriving information concerning medical attention to be provided to an individual, said derived information including information concerning a first body region of said individual that is to be subject to said medical attention; (col. 3, lines 42-55)
- selecting a single tattoo from said plurality of tattoos, said single tattoo being selected so as to convey guidance with respect to said medical attention to be

provided to said individual based on said derived information; and (col. 3, lines 42-55; col. 4, lines 40-67)

d'Arbelles discloses the method as described above but does not expressly disclose apply the tattoo to a second region of the body remove from the first. Keeton discloses a system and method for applying medical emblems to the skin, wherein an emblem may be applied to multiple (remote) regions of the body (Figure 3; col. 5, lines 18-28) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of d'Arbelles with the teaching of Keeton to apply the tattoo to multiple areas of the body. As suggested by Keeton, one would have been motivated to include this step to increase the likelihood that one label/emblem will be easily visible and available to provide patient information. (col. 5, lines 24-29)

[claim 2-3] d'Arbelles and Keeton teach the method of claim 1 as explained in the rejection of claim 1. Furthermore d'Arbelles discloses a method wherein the user (i.e. the individual seeking treatment) must fill out Advance Directives, information on Powers of Attorney, etc. d'Arbelles and Keeton in combination do not expressly disclose that information is derived from a discussion with the individual. However, it is respectfully submitted that at the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to discuss paperwork, medical background, and the medical markings with the prospective patient in the d'Arbelles method. As suggested by d'Arbelles, one would have been motivated to include this feature to

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ensure that the patient's wishes are emphasized to the medical staff. (col. 1, lines 53-62)

[claim 4] d'Arbelles discloses a method for conveying information according to the method of claim 1, wherein said single tattoo is selected from a kit containing a plurality of tattoos. (Figure 2)

[claim 5] d'Arbelles discloses a method for conveying information according to the method of claim 1, wherein said single tattoo is selected from the group consisting of a temporary tattoo transferable from a transfer sheet and a decal. (col. 2, line 66-col. 3, line 9; col. 4, lines 62-67)

[claim 6] d'Arbelles teaches a method for conveying information according to the method of claim 1, wherein at least one of said indicia for conveying medical treatment parameter information concerns non-use of antibiotic or medicine with respect to said individual. (col. 3, lines 48-55—e.g. on blood thinner)

[claim 7] d'Arbelles teaches a method for conveying information wherein at least one of said indicia for conveying medical treatment parameter information concerns non-treatment of said second body region. (col. 3, lines 48-55—DNR)

[claim 8] d'Arbelles teaches a method for conveying information according to the method of claim 1, wherein said single tattoo includes verbiage. (col. 3, lines 48-55—e.g. on blood thinner)

[claims 9-10] d'Arbelles teaches a method wherein said single tattoo includes a schematic depiction and wherein said schematic depiction includes a circle and diagonal bisecting line. (Figure 2—Caduceus, plain and inscribed)

[claim 11] d'Arbelles teaches a method for conveying information wherein at least one of said indicia for conveying medical treatment parameter information concerns medication dosage with respect to said individual. (col. 3, lines 48-55—e.g. on blood thinner—conveys that they are on a dosage of blood thinner)

[claim 12] d'Arbelles teaches a method for conveying information according to the method of claim 1, wherein at least one of said indicia for conveying medical treatment parameter information concerns authorized treatment with respect to said individual. (col. 3, lines 48-55—Heart/Lung/Kidney transplant)

5. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over d'Arbelles and Keeton as applied to claim 1, and in further view of Heeter (USPN 5,878,155)

[claims 13-14] d'Arbelles discloses a method and system for conveying medical information using tattoos (col. 3, lines 48-55), but does not expressly disclose that the tattoos are also scannable bar code correlating to a computer record concerning an individual. Heeter discloses a system and method for using tattoos that are also scannable bar codes to retrieve a computer record on an individual. At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art to further modify the method of d'Arbelles and Keeton in combination with the teach of

Heeter to use a barcode tattoo to retrieve information on an individual. As suggested by Heeter, one would have been motivated to include this feature to ensure that the medical information is kept privately and too easily accessible. (col. 2, lines 11-12)


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is (571) 272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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